

REMARKS**Summary of the Office Action**

Claim 3 stands objected to for minor informalities.

Claim 3 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,459,256 to *Zeigler* in view of Japanese Patent Application No. 7-88884 (“JP-884”).

Summary of the Response to the Office Action

Applicants have amended claims 1-3 to correct antecedent basis informalities and to better clarify the invention. Accordingly, claims 1-3 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

Claim 3 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Claim 3 has been amended to correct the ambiguities alleged in the Office Action. Applicant respectfully submits that claim 3 is in full compliance with 35 U.S.C. § 112, second paragraph. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Zeigler* in view of *JP-884*. Applicants respectfully traverse the rejection for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action fails to meet all three of these criteria. First, the Office Action fails to establish that there was some suggestion or motivation to combine the reference teachings. The Office Action states that the “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use light transmitting and light shielding resins as shown in the added reference, when performing the process set forth in the primary reference, for achieving a light effect with the molded key top.”

However, the molding process set forth in the *Zeigler* reference shows the opposite configuration where the button (2) is opaque being made from plastic and located on the top surface of the push button. The button (2) may be shaped as a numeral or a character symbol on the push button. The central portion (8) of the push button is also opaque being made from plastic and located on the back surface of the push button. See col. 2, lines 1-68 of *Zeigler*. Thus, there is no suggestion or motivation in either *Zeigler* or *JP-884* to combine these references because the combination cannot suggest “performing a second shot for injecting a light-shielding resin from a back side of said key top,” as recited in claim 1. Similarly, with respect to independent claim 2, neither *Zeigler* nor *JP-884* teaches or suggests “performing the second shot for injection light-shielding resin into a second space . . . to injection-mold said outer part and said inner part on a back surface of said light-permeable resin layer,” as recited in claim 2. See Fig. 2 of *Zeigler* and Fig. 4 of *JP-884*.

Second, neither *Zeigler* nor *JP-884* discusses a “light-shielding resin layer” injected “on a back surface of said light-permeable resin layer,” as recited in claims 1 and 2. Since none of the applied references teaches or suggests the above-mentioned features, one of ordinary skill in the art could not reasonably contemplate the invention as recited in independent claims 1 and 2 from the teachings of the applied references. Therefore, the Office Action fails to establish that there was a reasonable expectation of success.

Third, neither *Zeigler* nor *JP-884*, either alone or in combination teaches or suggests at least the features of “performing a second shot for injecting a light-shielding resin from a back side of said key top,” as recited in claim 1. Similarly, with respect to independent claim 2, neither *Zeigler* nor *JP-884* teaches or suggests “performing the second shot for injection light-shielding resin into a second space . . . to injection-mold said outer part and said inner part on a back surface of said light-permeable resin layer,” as recited in claim 2. Thus, the cited references fail to teach or suggest all claim limitations.

As previously mentioned, none of the applied references teach or suggest the above-mentioned features. M.P.E.P. § 2143.03 states, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). Thus, the Office Action fails to establish a *prima facie* case of obviousness at least because it does not teach all the recited claim features. Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 103(a) should be withdrawn because neither *Zeigler* nor *JP-884* teaches or suggests each feature of newly amended independent claims 1 and 2.

In view of the above arguments, Applicants respectfully request that the rejection of independent claims 1 and 2 under 35 U.S.C. § 103 be withdrawn. Additionally, claim 3, which now depends from independent claim 2, is allowable at least because its base claim is allowable, as well as for the additional features recited therein.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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